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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,098	03/01/2002	G. Eric Engstrom	109909-129542	1975

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EXAMINER

WEST, LEWIS G

ART UNIT PAPER NUMBER

2682

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,098

Applicant(s)

ENGSTROM ET AL.

Examiner

Lewis G. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

The affidavit improperly filed under 37 CFR 1.131 February 7, 2005 has been treated under 37 CFR 1.132 as it is an attempt to provide evidence against a rejection and does not swear behind any particular reference or date, and makes no attempt to show requisite parts of the invention or their interaction necessary for conception, much less diligence of any kind.

The affidavit under 37 CFR 1.132 filed February 7, 2005 is insufficient to overcome the rejection of claims 80-100 based upon new matter as set forth in the last Office action because: A statement that an invention that is not claimed could be practiced based on an application months before it existed is irrelevant and unpersuasive. The fact that a proposed expert states that a limitation can be reached without undue experimentation is irrelevant to whether it constitutes new matter, as matter must be supported by the original specification or originally claimed, and the limitations rejected under new matter were not and are not supported. Further the drawing in the exhibit does not clearly show any configuration, as it could just as easily be construed as one piece covering the keypad, and no explanation or legend is provided to prove otherwise.

Response to Arguments

Applicant's arguments filed February 7, 2005 have been fully considered but they are not persuasive. As stated with reference to the affidavit, new matter cannot be overcome with evidence that such a limitation may be arrived at without undue experimentation. This statement further proves applicant's limitation is either obvious or inherent and therefore not patentably distinct. The rejection stands and is now made final.

Claim Rejections - 35 USC § 112

Claims 80-100 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has no support for “partially covers a front surface of the body of the electronic apparatus not occupied by a display and a plurality of keys.” The portion of the specification cited as supporting this merely states that many configurations are possible, this does not provide support for the specific embodiment now claimed and argued by applicant as his invention. The drawings further fail to support this, as the description in the specification states that part of the cover is a sheet of rubber that covers the keypad.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 80-89 and 91-99 are rejected under 35 U.S.C. 102(e) as being anticipated by Wycherley (US2002/0030103).

Regarding claim 80, Wycherley discloses a cover comprising: a cover body to mate with a body of an electronic apparatus, to partially cover the body of the electronic apparatus, the front surface of the body of the electronic apparatus extending from a top edge of the body of the electronic apparatus to a bottom edge of the body of the electronic apparatus and from a left edge of the body of the electronic apparatus to a right edge of the body of the electronic apparatus, and the cover body having an exterior surface non-functionally decorated to provide the electronic apparatus with one or more visually perceivable attributes of the non-functional theme; and an electronic component embedded within the cover body, having data stored therein for customizing functions of the electronic apparatus to operate with characteristics complementary to the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the cover body to jointly effectuate a non-functional theme. (Figure 1, paragraphs 0004-0011; 0015-0030)

Regarding claim 81, Wycherley discloses the cover of claim 80, wherein the electronic component comprises data identifying to the processor of the body of the electronic apparatus, which group of a plurality of covering groups the cover is a member of, each covering group having a non-functional theme. (0017-0018)

Regarding claim 82, Wycherley discloses the cover of claim 80, wherein the data comprises at least one of a resource server specification, an email address, an electronic coupon, a font style, an identifier identifying the interchangeable cover, and an approval code. (0006,0018)

Regarding claim 83, Wycherley discloses the cover of claim 80, wherein the data comprises a selected one of a pointer to an audio data file and a audio data file, where the audio

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data file complements the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the cover body. (0006,0018)

Regarding claim 84, Wycherley discloses the cover of claim 80, wherein the data comprises at least a selected one of a pointer to a screen saver, a pointer to a video data file, a screen saver and a video data file, where the screen saver/video data file is complementary to the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the cover body. (0006,0018)

Regarding claim 85, Wycherley discloses the cover of claim 80, wherein the electronic component comprises a processor. (0017)

Regarding claim 86, Wycherley discloses a mobile phone comprising: a body including a top edge, a bottom edge, a left edge, a right edge, a front surface extending from the top edge to the bottom edge and from the left edge to the right edge, a display and a plurality of keys disposed on a plurality of regions of the front surface, and an internally disposed processor to execute one or more programming instructions; and an interchangeable cover to mate with the body, to partially cover the rest of the front surface, with the interchangeable cover having an exterior surface non-functionally decorated to provide the mobile phone with one or more visually perceivable attributes of a non-functional theme, and an electronic component embedded within the interchangeable cover, having data stored therein for customizing functions of the mobile phone to operate with characteristics complementary to the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the interchangeable cover to jointly effectuate the non-functional theme. (Figure 1, paragraphs 0004-0011; 0015-0030)

Regarding claim 87, Wycherley discloses the mobile phone of claim 86, wherein the electronic component of the interchangeable cover comprises data identifying to the processor of the body, which group of a plurality of interchangeable covering groups the corresponding interchangeable cover is a member of, each interchangeable covering group having a non-functional theme. (0006,0018)

Regarding claim 88, Wycherley discloses the mobile phone of claim 86, wherein the data comprises at least one of a phone number, a resource server specification, an email address, an electronic coupon, a font style, an identifier identifying the interchangeable cover, and an approval code. (0006,0018)

Regarding claim 89, Wycherley discloses the mobile phone of claim 86, wherein the data comprises a selected one of a pointer to an audio data file and a audio data file, where the audio data file complements the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the interchangeable cover. (0006,0018)

Regarding claim 91, Wycherley discloses the mobile phone of claim 89, wherein the audio data file facilitates modification of ring tones of the mobile phone to ring tones that are complementary to the visually perceivable attributes of the non-functional theme provided by the nonfunctional decorations of the exterior surface of the interchangeable cover. (0019-0030)

Regarding claim 92, Wycherley discloses the mobile phone of claim 86, wherein the data comprises at least a selected one of a pointer to a screen saver, a pointer to a video data file, a screen saver and a video data file, where the screen saver/video data file is complementary to the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the interchangeable cover. (0006,0018)

Regarding claim 93, Wycherley discloses the mobile phone of claim 86, wherein the electronic component comprises a processor. (0017)

Regarding claim 94, Wycherley discloses an electronic apparatus comprising: a body including a top edge, a bottom edge, a left edge, a right, a front surface extending from the top edge to the bottom edge and from the left edge to the right edge, a display and a plurality of keys disposed on a plurality of regions of the front surface, and an internally disposed processor to execute one or more programming instructions; and an interchangeable cover to mate with the body to partially cover the rest of the front surface, with the interchangeable cover having an exterior surface non-functionally decorated to provide the electronic apparatus with one or more visually perceivable attributes of a nonfunctional theme, and an electronic component embedded within the interchangeable cover, having data stored therein for customizing functions of the electronic apparatus to operate with characteristics complementary to the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the interchangeable cover to jointly effectuate the non-functional theme. (Figure 1, paragraphs 0004-0011; 0015-0030)

Regarding claim 95, Wycherley discloses the electronic apparatus of claim 94, wherein the electronic component of the interchangeable cover comprises data identifying to the processor of the body, which group of a plurality of interchangeable covering groups the corresponding interchangeable cover is a member of, each interchangeable covering group having a non-functional theme. (0006,0018)

Regarding claim 96, Wycherley discloses the electronic apparatus of claim 94, wherein the data comprises at least one of a resource server specification, an email address, an electronic

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coupon, a font style, an identifier identifying the interchangeable cover, and an approval code.

(0006,0018)

Regarding claim 97, Wycherley discloses the electronic apparatus of claim 94, wherein the data comprises a selected one of a pointer to an audio data file and a audio data file, where the audio data file complements the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the interchangeable cover.

(0006,0018)

Regarding claim 98, Wycherley discloses the electronic apparatus of claim 94, wherein the data comprises at least a selected one of a pointer to a screen saver, a pointer to a video data file, a screen saver and a video data file, where the screen saver/video data file is complementary to the visually perceivable attributes of the non-functional theme provided by the nonfunctional decorations- of the exterior surface of the interchangeable cover. (0006,0018)

Regarding claim 99, Wycherley discloses the electronic apparatus of claim 94, wherein the electronic component comprises a processor. (0017)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wycherley in view of Examiner's official notice.

Regarding claim 90, Wycherley discloses the mobile phone of claim 89, wherein the audio data file facilitates modification of audio of the mobile phone to audio that is complementary to the visually perceivable attributes of the non-functional theme provided by the non-functional decorations of the exterior surface of the interchangeable cover. (0017-0030) Wycherley does not expressly disclose the changing of a voice greeting. Examiner takes official notice that is notoriously well known in the art that voice greetings are a type of audio used in a portable phone that may be changed. It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to change a voice greeting when a cover is changed to reflect the other changes in visual and aural attributes changed by the cover.

Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wycherley in view of Sylvan.

Regarding claim 100, Wycherley discloses the electronic apparatus of claim 94, but does not expressly disclose a personal digital assistant (PDA). Sylvan discloses a device with a replaceable cover wherein the electronic apparatus comprises a personal digital assistant. (Sylvan col. 4 lines 42-55) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a replaceable cover with a PDA because they provide mobile functionality in common with and beyond that of a regular mobile phone and the same advantages of the mobile cover used with a phone could equally apply to a PDA.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

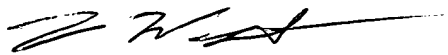
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 571-272-7859. The examiner can normally be reached on Monday-Friday 6:30-3:00.

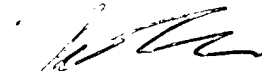
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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